REMARKS/ARGUMENTS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 12-25 are pending.

The outstanding Office Action rejects Claims 12, 14-16, and 21 under 35 U.S.C. § 102(e) as anticipated by Park (U.S. Patent No. RE37,052); rejects Claims 18-20 and 23-25 under 35 U.S.C. § 103(a) as unpatentable over Park in view of Cloutier, et al. (U.S. Patent No. 5,847,771, herein "Cloutier") and further in view of Tamada, et al. (U.S. Patent No. 5,729,717, herein "Tamada"); and rejects Claims 13, 17, and 22 under 35 U.S.C. § 103(a) as unpatentable over Park in view of Cloutier.

As an initial matter, Applicants note that Applicant has provided arguments that Applicant believes illustrate the deficiencies in rejecting Claims 12, 14-16, and 21 under 35 U.S.C. § 102(e), in rejecting Claims 18-20 and 23-25 under 35 U.S.C. § 103(a), and in rejecting Claims 13, 17, and 22 under 35 U.S.C. § 103(a) in the Amendment filed April 1, 2005.

Applicant respectfully submits that the outstanding Official Action is a substantial duplicate of the July 12, 2004 Official Action.

MPEP requires that all actions on the merits issued by the Office be complete and clear.[1] MPEP further requires that "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it."[2]

Applicant respectfully reminds the Examiner of our phone conversations of August 19, 2005 and September 28, 2005 where the nonresponsiveness of the outstanding Official Action was agreed upon with the Examiner indicating an intent to mail

[1] See MPEP § 707.07.

Applicant the correct Official Action which addresses the April 1, 2005 Amendment. Applicant has not yet received the corrected Official Action to the April 1, 2005 Amendment. Applicant has checked the USPTO PAIR system and verified that the last mailed Official Action is the outstanding nonresponsive Official Action of July 1, 2005, which is a substantial copy of the July 12, 2004 Official Action.

Applicant respectfully submits that the outstanding Official Action does not answer the substance of the April 1, 2005 Amendment. The outstanding Official Action responds to the April 1, 2005 Amendment by merely repeating the rejection made in the July 12, 2004 Official Action, and ignores the substance of the July 1, 2005 Amendment. Accordingly, the outstanding Official Action is not complete and clear. Applicant respectfully submits that MPEP § 707.07(f) indicates that a proper action is to take note of the points raised in traversing such a repeated rejection and answer the substance thereof. Applicant respectfully requests that the substance of the April 1, 2005 Amendment be answered in detail in a non-final Official Action, so that Applicant may have the opportunity to reply completely, and reiterates that arguments of the last Amendment below.

Applicants note that the Information Disclosure Statement filed June 20, 2000 has not been acknowledged. Applicants respectfully request that the Examiner consider the listed documents and indicate that they were considered by making appropriate notations on the attached form. For the Examiner's convenience, a copy of the date-stamped filing receipt and PTO-1449 form are filed herewith.

Rejection of Claims 12, 14-16, and 21 under 35 U.S.C. § 102(e)

In regard to the rejection of Claims 12, 14-16, and 21 under 35 U.S.C. § 102(e) as

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[2] See MPEP § 707.07(f).

anticipated by Park, Applicants respectfully traverse the rejection for the following reasons.

To establish anticipation of Claims 12, 14-16, and 21 under 35 U.S.C. § 102(e), the outstanding Office Action must show that each and every feature recited in Claims 12, 14-16, and 21 is either explicitly disclosed or necessarily present in Park.[3]

The outstanding Office Action asserts that Park discloses all of the features recited in Claims 12, 14-16, and 21. Applicants respectfully disagree.

Claim 1 recites a method of screening a digital recording apparatus to determine whether a digital signal may be received by the digital recording apparatus comprising, *inter alia*, steps of detecting whether the digital recording apparatus performs processing in compliance with copyright protection information and allowing a digital signal to be received by the digital recording apparatus in response to detection that the digital recording apparatus performs processing in compliance with the copyright protection information.

To meet the above-mentioned detecting and allowing steps of Claim 1, the outstanding Office Action cites reference numerals 21 and 22 of Figs. 4 and 5; and col. 9, line 50-col. 10, line 27 of Park.[4] Applicants respectfully submit that Park does not disclose or suggest steps of detecting whether a digital recording apparatus performs processing in compliance with copyright protection information and allowing a digital signal to be received by the digital recording apparatus in response to detection that the digital recording apparatus performs processing in compliance with the copyright protection information.

In Park, it is assumed that a digital magnetic recording/reproducing system has the capacity to perform copy protection processing to determine whether copying is permitted. In other words, in Park, it is assumed that the digital magnetic recording/reproducing system has the capacity to perform processing in compliance with copyright protection information. Park does not disclose or suggest the step of detecting whether the digital magnetic

[3] See MPEP § 2131.

recording/reproducing system performs processing in compliance with copyright protection information as a prerequisite to receiving the digital signal.

More specifically, in Park,

> the copy prevention apparatus of the digital magnetic recording/reproducing system according to the present invention includes a marker detecting/inserting section 21, a descrambler 24, a marker analyzing/processing section 22 and a buffer section 23.[5]
>
> That is, the input bit strips are supplied to marker analyzing/processing section 22 under the state that the marker is detected and decrypted in marker detecting/inserting section 21.[6]
>
> Encrypted marker EM is decrypted by means of the encoding key in marker analyzing/processing section 22 to detect the control word. At this time, the recording can be performed or not in accordance with the result of the analysis.[7]

In other words, in Park, the copy prevention apparatus of the digital magnetic recording/reproducing system is assumed to have the capacity to perform processing in compliance with copyright protection information (i.e., the marker in the input bit strips); and the copy prevention apparatus of the digital magnetic recording/reproducing system uses the copyright protection information in the input bit strips to determine whether or not copying is permitted. Thus, in Park, there is no need to detect whether a recording apparatus (i.e., DVCR) performs processing in compliance with copyright protection information. Nowhere does Park disclose or suggest the steps of detecting whether the digital recording apparatus performs processing in compliance with copyright protection information as a prerequisite to allowing a digital signal to be received by the digital recording apparatus in response to detection that the digital recording apparatus performs processing in compliance with the copyright protection information, as recited in Claim 1.

Accordingly, Applicants submit that Claim 12 is patentable and the rejection of

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[4] Office Action of December 2, pages 3-4.
[5] Col. 8, lines 1-5 of Park.
[6] Col. 9, lines 13-16 of Park.
[7] Col. 5, lines 17-21 of Park.

Claim 12 under 35 U.S.C. § 102(e) should be withdrawn. Independent Claims 16 and 21, although of different scope and/or statutory class, include features similar to those in Claim 12 discussed above. Claims 13 and 14 depend from Claim 12. Thus, Applicants respectfully request that the rejection of Claims 12, 14-16, and 21 under 35 U.S.C. § 102(e) be withdrawn as well.

Rejection of Claims 18-20 and 23-25 under 35 U.S.C. § 103(a)

In regard to the rejection of Claims 18-20 and 23-25 under 35 U.S.C. § 103(a) as unpatentable over Park in view of Cloutier and further in view of Tamada, Applicants respectfully traverse the rejection for the following reasons.

Claim 18, although of different scope and/or statutory class, include features similar to those in Claim 12 discussed above. Accordingly, as discussed above with respect to Claim 12, Park does not teach or suggest each and every element recited in Claim 18. For example, Park does not teach or suggest at least means for allowing the digital signal to be received by the digital recording apparatus in response to detection that the digital recording apparatus performs processing in compliance with the copyright protection information, as recited in Claim 18. Neither Cloutier nor Tamada cures the deficiencies of Park in this regard.

Accordingly, Applicants submit that Claim 18 is patentable and the rejection of Claim 18 under 35 U.S.C. § 103(a) should be withdrawn. Independent Claim 23, although of different scope and/or statutory class, includes features similar to those in Claim 18 discussed above. Claims 19, 20, 24, and 25 depend from Claim 18 or 23. Thus, Applicants respectfully request that the rejection of Claims 19, 20, and 23-25 under 35 U.S.C. § 103(a) be withdrawn as well.

Rejection of Claims 13, 17, and 22 under 35 U.S.C. § 103(a)

In regard to the rejection of Claims 13, 17, and 22 under 35 U.S.C. § 103(a) as unpatentable over Park in view of Cloutier, Applicants respectfully traverse the rejection for

the following reasons.

Claims 13, 17, and 22 depend from Claim 12, 16, or 21. As discussed above with respect to Claims 12, 16, or 21, Park does not teach or suggest each and every element recited in Claims 12, 16, or 21. For example, Park does not teach or suggest at least detecting whether a digital recording apparatus performs processing in compliance with copyright protection information and allowing a digital signal to be received by the digital recording apparatus in response to detection that the digital recording apparatus performs processing in compliance with the copyright protection information, as recited in Claim 12 and as similarly recited in Claims 16 and 21. Cloutier does not cure the deficiencies of Park in this regard.

In view of the failure of Park and Cloutier to teach or suggest all features of Claims 12, 16, and 21, Applicants respectfully submit that Park in view of Cloutier does not render Claims 12, 16, and 21 obvious under 35 U.S.C. § 103(a). Since Claims 13, 17, and 22 depend on Claim 12, 16, or 21, Applicants respectfully request that the rejection of Claims 13, 17, and 22 under 35 U.S.C. § 103(a) be withdrawn.

Accordingly, in view of the foregoing amendments and remarks, it is respectfully submitted that the present application, including Claims 12-25, is patentably distinguished over the prior art. If the Examiner agrees, the Examiner is invited to contact the undersigned, so that the undersigned can file a terminal disclaimer to formally put the application in condition for allowance.

Respectfully submitted,

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